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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,578	02/02/2006	Akio Noda	TOMI 200008	7248
27885	7590	04/20/2009		
Fay Sharpe LLP 1228 Euclid Avenue, 5th Floor The Halle Building Cleveland, OH 44115			EXAMINER THOMAS, BRANDI N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,578	Applicant(s) NODA ET AL.	
	Examiner BRANDI N. THOMAS	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 11-13, 16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 10, 14, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-6, 9, 10, 14, 15, and 17 in the reply filed on 7/30/08 is acknowledged.

Examiner's Comment

2. Claims 3-5, 9, 14, 15 and 17 were objected to as being in improper form because of multiple dependency and were not further treated on the merits. A new set of claims was filed on, May 19, 2005 and the claims were amended and put into proper form to remove any multiple dependency issues

Information Disclosure Statement

3. Acknowledgement is made of receipt of Information Disclosure Statement(s) (PTO-1449) filed 5/19/05. An initialed copy is attached to this Office Action.

Claim Objections

4. Claims 1 and 9 are objected to because of the following informalities: Claims 1 and 9 include subject matter in parentheses. Parentheses should be deleted. Appropriate correction is required.
5. The objection to claims 3-5, 9, 14, 15, and 17, with regards to multiple dependencies has been withdrawn.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "optical element, and the claim also recites "such as a crystal" which is the narrower statement of the range/limitation. In the present instance, claim 4 recites the broad recitation "the planar shape of the optical element is any of a rectangle, a circle, an ellipse, and a polygon", and the claim also recites "such as a triangle, a parallelogram, and a hexagon" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1, 2, 4-6, 9 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Newman (WO/9220001).

Regarding claim 1, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the optical element fixing structure (100) is an optical element fixing structure (100) to fix an optical element (102) which comprises an optical element (102) and an optical element holder (104) to fix and mount the optical element (102) (page 11, lines 12-15), in that the optical element (102) has one or multiple slits (110, 112, and 114) in the thickness direction in an outer edge part thereof which is present on the optical element (102) but outside a working surface of the optical element (102) and can be used as a portion to fix the optical element (102) to the optical element holder (104) (page 11, lines 22-25); and in that the optical element holder (104) has depressing means to fix the optical element (102) by depressing at least one of the front surface (118) and the back Surface of the optical element (102) outside the slit (110, 112, and 114) (page 12, lines 3-11).

Regarding claim 2, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the depressing means depresses only one surface, which is one of the back surface and the front surface (118) of the optical element (102) (page 12, lines 3-11).

Regarding claim 4, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the planer shape of the optical element is any of a rectangle, a circle, an ellipse and a polygon, such as a triangle, a parallelogram and a hexagon (figure 6).

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Regarding claim 5, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the slit has a depth sufficient for preventing the propagation of only depression strain of the optical element to the working surface of the element (page 12, lines 8-15).

Regarding claim 6, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the slit has a depth which is not less than half the thickness of the optical element (102) (page 11, lines 27-31).

Regarding claim 9, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the slit is a linear structure at least one end of which is open to a side surface of the optical element which surface is the surface which connects the front surface and the back surface together; this applies also in the following (figure 6).

Regarding claim 17, It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiated the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Ex parte Mashim, 2 USPQ2d 1647 (1987)).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 3, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (WO/9220001) as applied to claim 1 above, and further in view of Yomo et al. (JP 360063739A).

Regarding claim 3, Newman discloses the claimed invention but does not specifically disclose characterized in that the depressing means is an elastic body attached to the optical element holder. Yomo et al. discloses characterized in that the depressing means is an elastic body (3, 4, 5, and 6) attached to the optical element holder (2) (constitution). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Newman with the elastic body of Yomo et al. for the purpose of tracking and auto-focusing (constitution).

Regarding claim 14, Newman discloses the claimed invention but does not specifically disclose characterized in that the elastic body is a plate spring. Yomo et al. discloses characterized in that the elastic body (3, 4, 5, and 6) is a plate spring (constitution). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Newman with the elastic body of Yomo et al. for the purpose of tracking and auto-focusing (constitution).

Regarding claim 15, Newman discloses the claimed invention but does not specifically disclose characterized in that the elastic body is provided on a surface of a base for fixing the elastic body, in that the base for fixing the elastic body is provided in a bottom part of the optical element holder, and in that on the back surface of the base for fixing the elastic body there is provided adjusting means, which is capable of adjusting the depression by the elastic body by up-and-down movements of the base for fixing the elastic body, in such a manner as to pierce

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through the optical element holder. Yomo et al. discloses characterized in that the elastic body (3, 4, 5, and 6) is provided on a surface of a base for fixing the elastic body (3, 4, 5, and 6), in that the base for fixing the elastic body (3, 4, 5, and 6) is provided in a bottom part of the optical element holder (2), and in that on the back surface of the base for fixing the elastic body (3, 4, 5, and 6) there is provided adjusting means, which is capable of adjusting the depression by the elastic body by up-and-down movements of the base for fixing the elastic body (3, 4, 5, and 6), in such a manner as to pierce through the optical element holder (2) (constitution). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Newman with the elastic body of Yomo et al. for the purpose of tracking and auto-focusing (constitution).

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (WO/9220001) as applied to claim 1 above, and further in view of Maurer (6483651).

Regarding claim 10, Newman discloses, in figures 6-9, an optical element fixing structure (100) (page 11, lines 10-12), characterized in that the slits (110, 112, and 114) are provided in at least two locations of the outer edge part of the optical element (102), one slit for each location (page 11, lines 27-31) but does not specifically disclose that the optical element is in the shape of a rectangle. Maurer discloses, in figure 3, an optical element (12) in the shape of a rectangle (col. 5, lines 2-3). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Newman with the rectangular lens of Maurer for the purpose of constructing the lens to fit the rectangular frame (col. 5, lines 2-3).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI N. THOMAS whose telephone number is (571)272-2341. The examiner can normally be reached on Monday - Thursday from 6-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandi N Thomas/
Examiner
Art Unit 2873

BNT

/Ricky L. Mack/
Supervisory Patent Examiner, Art Unit 2873